



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

*#10/ Appeal
Brief
Admitted
1/27/03*

Application of:)
KLOSTERMAN, WADE C.)
Serial No.: 09/613,514)
Filed: 07/10/2000)
Title:)
VOICE FEEDBACK TIMER SYSTEM)

Docket No.: 27553
Group Art Unit No.: 2841
Examiner: Miska, Vit W

APPEAL BRIEF

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Assistant Commissioner of Patents
Washington, D.C. 20231

APPLICANT'S BRIEF ON APPEAL

In response to the Office Action dated July 16, 2002, Applicant's Brief on Appeal in accordance with 37 C.F.R. §1.192 is hereby submitted in triplicate. The Examiner's rejections of claims 1-11 and 15-18 as last amended are herein appealed, and allowance of said claims is respectfully requested.

The requisite fee of \$160.00 as required by 37 C.F.R. §1.17(c) is submitted herewith. Any additional fee which is due in connection with this amendment should be applied against Deposit Account No. 19-0522.

Respectfully submitted,

By

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Following are the requisite statements under 37 C.F.R. §1.192:

I. Real Parties in Interest

Wade C. Klosterman is the sole inventor of the claimed invention. Assignment by Wade C. Klosterman was executed on July 7, 2000, to WC Man Productions, the real party in interest.

II. Related Appeals and Interferences

No related appeals or interferences are known to the Appellants which may directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The application, as originally filed, contained eleven (11) claims, with claims 1 and 6 being the only independent claims.

A first Office Action was mailed on October 26, 2001, rejecting claims 1-5 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,854,774 to Timme in view of U.S. Patent No. 4,379,640 to Inoue, and rejecting claims 6-11 under 35 U.S.C. §103(a) as being unpatentable over Timme and Inoue in further view of U.S. Patent No. 5,444,673 to Mathurin. In response, arguments were made that the cited references themselves provided no relevant motivation or suggestion to combine their teachings, and that the motivations asserted by the Examiner would both fail to result in the claimed invention and

render the references unsuitable for their intended purposes. Additionally, seven (7) new claims, claims 12-18, were added, with claims 12, 15, and 18 being independent.

A second Office Action was mailed on July 16, 2002, rejecting claim 12 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,690,566 to Robertson; repeating the aforementioned rejections of claims 1-5 under 35 U.S.C. §103(a) over Timme in light of Inoue and of claims 6-11 under 35 U.S.C. §103(a) over Timme and Inoue and in further view of Mathurin; rejecting claims 13-14 under 35 U.S.C. §103(a) over Robertson; rejecting claims 15-17 under 35 U.S.C. §103(a) over Robertson in view of Inoue; and rejecting claim 18 under 35 U.S.C. §103(a) over Robertson in view of Inoue and Mathurin. These rejections were made final. In response, a Notice of Appeal was filed.

Claims 1-18 are currently pending. Claims 12, 13, and 14, however, are withdrawn from consideration on appeal. Thus, the rejections of claims 1-11 and 15-18 are appealed.

IV. Status of Amendments

All amendments submitted by the Appellant have been entered.

V. Summary of the Invention

It is often desirable to measure the passing of a time period in order to limit the duration of an activity. Commonly, this involves using an alarm clock or wristwatch to measure the passing of time and to indicate the expiration of a predefined period of time. Relatively sophisticated apparatuses exist, such as the aforementioned alarm clock and wristwatch, which are able to measure periods of time with reference to an actual time of

the day. Though varying in complexity, cost, and available functions, these apparatuses typically include a timekeeping function comprising a clock and an associated display whereby the actual time of the day is displayed; a timer and an associated alarm; mechanisms whereby the clock and alarm may be set; and a "snooze" or delay function. Because these apparatuses inseparably combine the roles of general timekeeping and fixed-period timing, users requiring only a timing function are forced to purchase, carry, program, and use the inseparable timekeeping function as well. Thus, rather than merely setting a timer, a user must convert the length of the desired timed period into an actual time of the day and then set the alarm with reference to that actual time. For example, if, at 11:52am, a user wishes to time a fifteen minute period, he or she would have to calculate that the corresponding ending time would be 12:07pm, and would then have to enter this time by setting the hour, the minute, and the am/pm indicator. Depending on the mechanism provided for entering the desired time, the user might have to wait as each digit or value advances from some default or previously set starting value to the desired value. Once the alarm is set relative to actual time, additional steps may be required to activate the alarm such that it will sound when the set time is reached. Because of the inefficiency of associating simple fixed period timing with actual time, such apparatuses are much too inefficient, complex, and expensive for users requiring a simple timer.

Another disadvantage of conventional timers and alarm clocks, particularly for those with vision-related disabilities, is the lack of any non-visual feedback from the apparatus indicating, for example, that the alarm has been set or cleared, or which of different types of alarms will sound when the set time has been reached. Also, conventional timers and

alarm clocks are typically limited to alarms consisting of either nonsense tones or radio programming with no capability for customization.

The present invention provides a timing device (10) adapted to measure discrete intervals of time without reference to an actual time of day, and to allow for substantial flexibility with regard to the nature of the alarm communicated at the expiration of the timed period. In a preferred embodiment, the device (10) broadly comprises a timer (12); a minute button (14); an hour button (16); a controller (18); a voice chip (20); a record button (22); a microphone (24); a memory element (26); a speaker (28); an earphone jack (30); a snooze button (32); and a housing (34). See pages 3-4 of the application.

The timer (12) is operable to measure the length of the desired period of time without reference to the actual time of day. See page 4. The minute and hour buttons (14,16) allow for setting the length of the timed period, and the snooze button (32) allows for extending the length of the timed period following its initial expiration. See page 4. The minute button (14) is associated with fifteen minute periods and may be depressed up to three times, each of which adds an additional fifteen minutes to the timed period, for a maximum of forty-five minutes. See page 4. Similarly, the hour button (16) is associated with one hour periods and may be depressed up to four times, each of which adds one hour to the length of the timed period, for a maximum of four hours. See page 4. Five seconds after either the minute or hour buttons (14,16) are activated the controller (18) will cause the timer (12) to run, thereby avoiding any problem of setting but forgetting to activate the alarm. See page 4. If, however, the minute button (14) is pressed a fourth time, or the hour button (16) is pressed a fifth time, then the timer (12) will clear and no

timing will occur, or, if already started, will stop and clear. See page 4. Thus, the device (10) advantageously allows both the alarm to be set and the timing function initiated by depressing a single button representing a discrete unit of time (e.g., one hour, fifteen minutes). In an alternative embodiment, the device (10) includes a scan button which, when depressed, operates to cause the device (10) to audibly advance or scan through a number of choices or settings. See page 7.

At the end of the timed period, the controller (18) initiates the sounding of the alarm and controls playback of feedback announcements when appropriate. See page 5. The voice chip (20) allows the device (10) to produce human speech for replaying recorded messages and for providing feedback announcements regarding the setting or clearing of the timed period or other operation of the device (10). See page 5. The record button (22), microphone (24), and memory element (26) cooperate to allow for recording a message for future playback. See page 5. The alarm, whether chimes or message playback, and the feedback announcements may be communicated through the speaker (28). See page 6. Where such generally audible communication is not desired, earphones may be electrically connected to the earphone jack (30) to bypass the speaker and allow for listening without disturbing others or informing others of the contents of the recorded messages. See page 6.

Thus, using the present invention rather than the prior art alarm clock or wristwatch described above, the user, at 11:52am, wishing to time a fifteen minute period, need merely depress the minute button (14) once. Advantageously, it is not necessary to calculate or set the corresponding time (i.e., 12:07pm) or to depress any other buttons or

take any other action. As mentioned, the timing begins automatically five seconds later, thereby advantageously avoiding any problem of setting but forgetting to activate the alarm. Furthermore, by eliminating timekeeping in favor of timing, and by limiting the length of the timed period to discrete multiples of a predetermined number of minutes or hours, the present invention allows for a less complex, less expensive, and lighter timing device which is much easier and faster to use than prior art alarm clocks or wristwatches. Users who frequently nap for discrete blocks of time, truckdrivers and students for example, will appreciate that the alarm may be set and the timing initiated with as little effort as the push of a single button. Travelers will appreciate the device's light weight and lack of dependence on local time.

Another advantage of the present invention, particularly for those with vision-related disabilities, is its ability to provide the aforementioned audible feedback announcements indicating the operation or operative mode of the device, including that the alarm has been set or cleared and which of the different alarm types will sound at the end of the timed period. These audible feedback announcements are also advantageous for users who do not wish or are unable to direct their attention to a display for information concerning operation of the device (10).

Another advantage of the present invention is its ability to record the aforementioned short messages to be played at the end of the timed period in lieu of a default alarm tone. This allows a user to remind him- or herself or another of an important event or action to take upon expiration of the timed period.

VI. Issues

1. Whether, with regard to the rejections of claims 1-5 under 35 U.S.C. §103(a) over Timme in light of Inoue, the Examiner has established the requisite *prima facie* case of obviousness.

2. Whether, with regard to the rejections of claims 6-11 under 35 U.S.C. §103(a) over Timme in view of Inoue and in further view of Mathurin, the Examiner has established the requisite *prima facie* case of obviousness.

3. Whether, with regard to the rejections of claims 15-17 under 35 U.S.C. §103(a) over Robertson in view of Inoue, the Examiner has established the requisite *prima facie* case of obviousness.

4. Whether, with regard to the rejection of claim 18 under 35 U.S.C. §103(a) over Robertson in view of Inoue and Mathurin, the Examiner has established the requisite *prima facie* case of obviousness.

5. Whether, with regard to the rejections of claims 1-11 and 15-18 under 35 U.S.C. §103(a), the Examiner has, as required, considered the invention as a whole.

VII. Grouping of Claims

In accordance with 37 C.F.R. §1.192(c)(7), it shall be noted that the claims stand and fall together.

VIII. Arguments and Authorities

- A. The Examiner has failed, with regard to the rejections of claims 1-11 and 15-18 under 35 U.S.C. §103(a) to establish the requisite *prima facie* cases of obviousness.**

Obviousness, it will be appreciated, can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has the benefit of the Applicant's disclosure as a blueprint and guide, whereas one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the Applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection. For these reasons, MPEP §2142 places upon the Examiner the initial burden of establishing a *prima facie* case which requires, among other things, that there be identified some motivation or suggestion in the prior art or in the knowledge of one with ordinary skill to modify the reference or to combine reference teachings. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. See *In re Rijckaert*, 28 USPQ2d 1955, 1956

(Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

More specifically, three criteria must be satisfied in order to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all the claim limitations. See MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992) (reversing an obviousness rejection where there was no suggestion to modify a prior art mower strip to make it entirely flexible as required by applicant's claims toward a flexible landscape edging strip.); see also *In re Gordon*, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984). Additionally, "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01.

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. See *In re Vaeck*, 20

USPQ 2d 1438, 1442 (Fed. Cir. 1991). Thus, "[m]easuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See e.g., *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

- a. *The Examiner has failed, with regard to the rejections of claims 1-5 under 35 U.S.C. §103(a) over Timme in light of Inoue, to establish the requisite prima facie case of obviousness.*

The Examiner's rejections of claims 1-5 under 35 U.S.C. §103(a) rely on combining the teachings of Timme with those of Inoue. Though it may be possible to modify the cited references in the manner suggested by the Examiner, the proposed modifications run contrary to the expressed purposes of the teachings of the cited references and therefore it cannot be said that the cited references suggest the desirability of the proposed modifications, in which case the proposed modifications cannot be obvious. Thus, the Examiner has failed to establish the requisite *prima facie* case of obviousness and the rejections cannot be sustained.

Timme discloses a medical timing system (10) for assisting medical personnel in providing efficient and safe medical care to patients while decreasing the level of stress experienced by the medical personnel by allowing for the monitoring of up to five different patient activities simultaneously. It is an expressed object of Timme to decrease the stress

of medical personnel. See col. 2, lines 45-46. Thus, Timme is expressly designed and contemplated for use in a particular context and environment involving patient care.

The system (10) comprises a housing structure (20); a power supply (50) secured within the housing structure (20); a timing means (30) electronically connected to the power supply (50) and secured to the housing structure (20); and a securing means (40) mounted to a rear exterior surface of the housing structure (20). The timing means (30) includes a central processing unit (76); a plurality of time set buttons (37); a plurality of preset time buttons (39); a first LED display (31), a second LED display (32), a third LED display (33), a fourth LED display (34), and a fifth LED display (35); a start button (79) and a stop button (80); a central LED clock (36); an HR-RR LED display (38); and a set key (72) protected by a set button guard (74) for preventing accidental manipulation of programmed information in the central processing unit (76).

In use, the central processing unit (76) is programmed by first pressing the set key (72) and then pressing the time set buttons (37) to set the preferred time for each of the five individual timers. The user then presses the set key (72) again to start the timing and to prevent accidental manipulation of the programmed preferred time. When the central processing unit (76) determines that one of the timers has expired, it activates a speaker (78) which gains the user's attention.

Timme fails to disclose a number of advantageous features provided by the present invention, including, for example, the feature of allowing the alarm to be set and the timing function initiated with the push of a single button. Instead, Timme requires that at least three buttons be pushed, including first the set button to allow for programming the central processing unit, then the time set buttons to set the preferred time, and lastly the set button

again to start timing and to prevent accidental reprogramming of the preferred time. Timme requires this additional complexity because of the use it is put to and the importance of its timekeeping function. Thus, for example, Timme requires inclusion of the set button to protect against reprogramming because Timme is designed for use in a patient care environment where extremely accurate timekeeping may be necessary for life, health, and other safety reasons and where bumping or jarring the timing system, it being worn or carried on a healthcare practitioner's person, might otherwise result in reprogramming. Thus, Timme would not function as it was designed to or meant to without the aforementioned added complexity. Such added complexity, however, is a nuisance in applications for which the present invention is designed and contemplated. More specifically, the present invention is designed for measuring a limited selection of discrete periods of time and is not particularly meant to be worn or carried and therefore is at substantially less risk of being reprogrammed. Thus, Timme does not disclose the present invention's advantageous feature of one-button combined programming and automatic initiation of the timed period; nor can it be said to suggest the desirability of this feature because one-button combined programming and initiation does not provide sufficient protection against accidental reprogramming, and such protection is necessary to Timme.

Furthermore, as the Examiner admitted, Timme does not disclose the "announcement of data relating to the operating mode of a timepiece by means of synthesized human speech". In rejecting this feature of the present invention, the Examiner was forced to combine the teachings of Timme with those of Inoue. In doing so, however, the Examiner was unable to find a suggestion or motivation in the cited prior art

references themselves, and was therefore forced to create a motivation in the form of an entirely conclusory statement:

“One skilled in the art having both references would be taught that the operative modes of the timer in Timme may be audibly announced by means of audible speech, as done in the timekeeping device of Inoue, as an additional means of confirming data selection.” See Count 2 of the Office Action dated October 26, 2001.

The motivation created by the Examiner is not found in the references themselves and, in fact, runs counter to the teachings of Timme. As mentioned, it is an expressed object of Timme to reduce the stress of medical personnel and to provide for the monitoring of multiple patients. It will surely be appreciated that audible confirmations of potentially frequent programming would add to rather than reduce the stress on medical personnel. Furthermore, in a patient-care environment the audible confirmations would be highly undesirable, particularly from the standpoint of adding to or producing undue noise which might wake or otherwise upset patients. Thus, because the proposed modification of Timme would render it unsatisfactory for its expressed intended purpose, *there can be no motivation or suggestion to make the proposed modification*. See MPEP §2143.01.

In response to this argument, the Examiner reasserted the aforementioned rejection in Count 3 of the Office Action dated July 16, 2002, and stated:

"There is nothing in Timme which would preclude the use of voice announcements of any of the timer modes. The timer is merely an equivalent of a conventional timepiece with timer capability and plural timer modes. Timepieces with voice announcements are well known, as evidenced by the noted prior art, and any inconvenience associated with voice notification inherent thereto would likewise be applicable to timers of the type disclosed in Timme or claimed by the applicant." Count 8 of the Office Action dated July 16, 2002.

The Examiner fails to recognize the fact that, while timepieces with voice announcements may be well-known, this does not support the proposed modification of Timme given that such modification would render Timme unsuitable for its expressed purposes. As mentioned, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

As mentioned, obviousness rejections are exceedingly problematic and, by their nature, difficult to overcome. It is against unsupported motivations and suggestions and mere conclusory statements, as are offered in the present case, that the court sought to protect when it admonished against impermissible hindsight reconstruction. If unsupported motivations and suggestions and mere conclusory statements were sufficient bases for an obviousness rejection, then the most subjective and weakest of all grounds for rejection would become the most difficult to surmount.

As the Examiner has failed to establish the requisite *prima facie* case of obviousness, the rejections under 35 U.S.C. §103(a) over Timme in view of Inoue cannot be sustained and must be overturned.

- b. The Examiner has failed, with regard to the rejections of claims 6-11 under 35 U.S.C. §103(a) over Timme in light of Inoue and further in light of Mathurin, to establish the requisite prima facie case of obviousness.*

The Examiner's rejections of claims 6-11 under 35 U.S.C. §103(a) rely on combining the teachings of Timme with those of Inoue and with those of Mathurin. Though it may be possible to modify the cited references in the manner suggested by the Examiner, the proposed modifications run contrary to the expressed purposes of the teachings of the cited references and therefore it cannot be said that the cited references suggest the desirability of the proposed modifications, in which case the proposed modifications cannot be obvious. Thus, the Examiner has failed to establish the requisite *prima facie* case of obviousness and the rejections cannot be sustained.

As admitted by the Examiner, Timme does not disclose the feature of recording, storing, and playing back audible messages at the end of the timed period. Thus, in rejecting claims 6-11, the Examiner is forced to rely upon the combination of Timme, Inoue, and Mathurin, wherein Mathurin is asserted to disclose the feature in question. As stated by the Examiner, "[o]ne skilled in the art would thus be taught to provide this feature in the timer of Timme as a further convenient feature for alarm time announcement".

Again, an expressed object of Timme is to reduce the stress of medical personnel and to provide for the monitoring of multiple patients. It will surely be appreciated that the audible announcement of up to five messages at once would add to rather than reduce stress on medical personnel. Furthermore, in a patient-care environment the unexpected announcement of audible messages would be highly undesirable, both from the standpoint of violating patient confidentiality and from the standpoint of adding to or producing undue noise which might wake or otherwise upset patients. Again, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The Examiner's proposed modification of Timme would definitely not increase convenience nor be desirable given Timme's expressed purposes. Thus, it cannot be said to be obvious to combine Timme with Mathurin to provide this feature of the present invention because doing so would render Timme unsuitable for accomplishing its expressed and implied purposes.

As the Examiner has failed to establish the requisite *prima facie* case of obviousness, the rejections under 35 U.S.C. §103(a) over Timme in view of Inoue and further in view of Mathurin cannot be sustained and must be overturned.

- c. *The Examiner has failed, with regard to the rejections of claims 15-17 under 35 U.S.C. §103(a) over Robertson in view of Inoue, to establish the requisite prima facie case of obviousness.*

The Examiner's rejections of claims 15-17 under 35 U.S.C. §103(a) rely on combining the teachings of Robertson with those of Inoue. Though it may be possible to modify the cited references in the manner suggested by the Examiner, the proposed modifications run contrary to the expressed purposes of the teachings of the cited references and therefore it cannot be said that the cited references suggest the desirability of the proposed modifications, in which case the proposed modifications cannot be obvious. Thus, the Examiner has failed to establish the requisite *prima facie* case of obviousness and the rejections cannot be sustained.

Robertson discloses a programmable timing device for producing a signal after expiration of one or more timing periods, with each actuation of a programming switch representing one such timing period, and the device including a lockout circuit which, after a short interval, precludes any modification of the program introduced by the programming circuit. See col. 2, lines 10-13 (the Abstract). The device includes a programming switch (10) connected to a debounce circuit and providing input to a NAND gate (12); a lockout latch; an oscillator; a frequency divider; a counter; and a beep circuit. Actuating the programming switch (10) releases the lockout latch, starts the oscillator, and programs the counter with one discrete interval per actuation. See col. 3, lines 2-32. The frequency divider begins receiving signals from the oscillator; after a predefined interval following actuation of the programming switch (10), the lockout latch prevents any further programming input from the programming switch (10); the counter begins receiving signals from the frequency divider, and, in response thereto, decrements itself; and when the counter reaches zero the beep circuit produces an alerting audio tone. See col. 3, lines 2-32.

Robertson focuses on a particular use for the device involving alerting children to return home. Robertson describes the device as being specifically adapted for that use:

In use, the device could be packaged in a small portable enclosure such as a conventional wristwatch, a locket or pendant, adapted to be worn by a child. The only control device which need protrude from the package is the programming pushbutton, the device could be adapted to be powered by an electronic wristwatch battery which is replaced no more often than it would be in such a wristwatch. Because the circuitry is adapted to be made from CMOS logic elements which draw an extremely small amount of power, no power on/off switch would be necessary. Col. 2, lines 27-37.

To justify combining the teachings of Robertson with those of Inoue, the Examiner asserts:

One skilled in the art having both references would have a suggestion of using voice synthesized announcement of the operation modes of a timepiece in any timepiece where such announcement would be suitable the Robertson device is such a suitable device for voice announcements to facilitate in recognition of the time periods being set. Thus, voice feedback signals in the timer of Robertson would be an obvious addition, as taught by Inoue. See Count 6 of the Office Action dated July 16, 2002.

Recall, however, that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), *see also In re Gordon*, 221 USPQ2d 1125, 1127 (Fed. Cir. 1984). Additionally, "if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01.

The Examiner's assertion is substantially conclusory - essentially, "it can be done, therefore it would have been obvious to do it". However, Robertson is, in fact, not a suitable device for voice announcements. As mentioned, Robertson envisions its device packaged in a small portable enclosure and using so little power that it can be powered by a wristwatch battery. The Examiner's proposed modification would require, at the very least, a speaker, a memory to store audio messages or instructions for generating audio messages, voice simulation circuitry, and a power source sufficient to supply power to these added components as they perform their complex functions. With these modifications, the device would certainly no longer fit within the space provided by a conventional wristwatch, a locket or a pendant, as Robertson envisioned, and would likely be too large, heavy, and expensive to be desirable for wear by a playing child. Thus, Robertson cannot be said to suggest the desirability of the proposed modification because the proposed modification would render Robertson unsatisfactory for its expressed purposes.

As the Examiner has failed to establish the requisite *prima facie* case of obviousness, the rejections under 35 U.S.C. §103(a) over Robertson in view of Inoue and cannot be sustained and must be overturned.

- d. *The Examiner has failed, with regard to the rejection of claim 18 under 35 U.S.C. §103(a) over Robertson in view of Inoue and Mathurin, to establish the requisite prima facie case of obviousness.*

The Examiner's rejections of claim 18 under 35 U.S.C. §103(a) relies on combining the teachings of Robertson with those of Inoue and with those of Mathurin. Though it may be possible to modify the cited references in the manner suggested by the Examiner, the proposed modifications run contrary to the expressed purposes of the teachings of the cited references and therefore it cannot be said that the cited references suggest the desirability of the proposed modifications, in which case the proposed modifications cannot be obvious. Thus, the Examiner has failed to establish the requisite *prima facie* case of obviousness and the rejections cannot be sustained.

As admitted by the Examiner, Robertson does not disclose the feature of recording, storing, and playing back audible messages at the end of the timed period. Thus, in rejecting claim 18, the Examiner is forced to rely upon the combination of Robertson, Inoue, and Mathurin, wherein Mathurin is asserted to disclose the feature in question. The Examiner asserts:

The same reasons for obviousness are noted here as for claims 15-17.

Further, storage and playback of alarm messages is conventional, as shown in Mathurin. One skilled in the art would provide this convenient feature in the Robertson device for announcing intervals. Count 7 of the Office Action dated July 16, 2002.

Again, the mere fact that the proposed modification of the prior art may be possible does not equate to the proposed modification being consistent with the expressed purposes or uses of the prior art, and is therefore, by itself, an insufficient basis upon which to assert obviousness. The Examiner's simple statement that "[o]ne skilled in the art would provide this convenient feature in the Robertson device" indicates that the Examiner did not consider the impact of the proposed modification on the expressed use of Robertson device.

As mentioned, Robertson envisions its device packaged in a small portable enclosure and using so little power that it can be powered by a wristwatch battery. The Examiner's proposed modification would require, at the very least, a speaker, a memory to store audio messages or instructions for generating audio messages, voice simulation circuitry, and a power source sufficient to supply power to these added components as they perform their complex functions. With these modifications, the device would certainly no longer fit within the space provided by a conventional wristwatch, locket, or pendant as Robertson envisioned, and would likely be too large, heavy, and expensive to be desirable for wear by a playing child. Thus, Robertson cannot be said to suggest the desirability of

the proposed modification as the proposed modification would render Robertson unsatisfactory for its expressed purpose.

As the Examiner has failed to establish the requisite *prima facie* case of obviousness, the rejections under 35 U.S.C. §103(a) over Robertson in view of Inoue and further in view of Mathurin cannot be sustained and must be overturned.

B. The Examiner has not, with regard to the rejections of claims 1-11 and 15-18 under 35 U.S.C. §103(a), considered the invention as a whole.

The Examiner's rejections of claims 1-11 and 15-18 under 35 U.S.C. §103(a) rely on combining the teachings of a number of references to account for all of the claimed features. The Examiner's fabrication of unsupported motivations for making such combinations indicates that the Examiner did not consider the invention as a whole. Instead, the Examiner appears to have attempted to identify a prior art reference for each separate feature in turn and then attempted to combine those references without serious consideration as to whether the proposed combinations or motivations for doing so made sense in light of the very different purposes expressed in those references.

"In the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP §2141.02. Relying on a different reference, as the Examiner has, to reject each feature separately runs contrary to considering the invention as a whole. Even if these references can be said

to have been properly and validly combined and that the requisite *prima facie* case of obviousness has been made, the question remains as to whether the invention as a whole, which is more than the mere sum of its features, has been properly considered. The mere fact that the various features of the present invention can be found over a number of disparate references and that a motivation can be fabricated for combining one with another does not make the present invention as a whole obvious. If such a rejection were allowed, then any and every claimed invention is easily rejected by merely reducing it to such a degree that its constituent components can be found among the over six million issued patents.

The Applicant respectfully asserts that the Examiner has treated the claimed features individually and without regard for the invention as a whole, thereby further invalidating the Examiner's 35 U.S.C. §103(a) rejections. As the Examiner has failed to comply with the requirement of considering the invention as a whole, the rejections under 35 U.S.C. §103(a) relying on improper combinations of numerous references cannot be sustained and must be overturned.

C. Conclusion

The Examiner has failed, with regard to the rejections of claims 1-11 and 15-18 under 35 U.S.C. §103(a) to establish the requisite *prima facie* cases of obviousness. Specifically, the motivations created by the Examiner are improper and their desirability is not supported in the prior art teachings because the proposed modifications would render the prior art references unsuitable for their expressed purposes. As the Examiner has

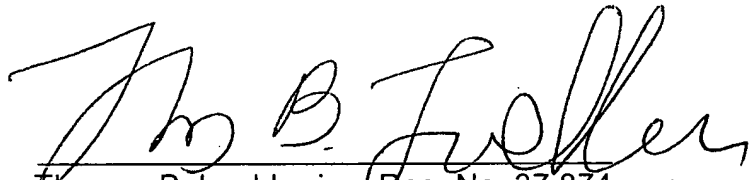
failed to establish the requisite *prima facie* case of obviousness, the rejections under 35 U.S.C. §103(a) cannot be sustained and must be overturned.

Furthermore, the Examiner has not, with regard to the rejections of claims 1-11 and 15-18 under 35 U.S.C. §103(a), considered the invention as a whole. Specifically, the Examiner has identified prior art references to account for the separate features of the present invention and then attempted to improperly string those references together using unsupported motivations to reject the claims. Relying on a different reference to reject each feature separately runs contrary to considering the invention as a whole. As the Examiner has failed to comply with the requirement of considering the invention as a whole, the rejections under 35 U.S.C. §103(a) relying on improper combinations of numerous references cannot be sustained and must be overturned.

Accordingly, reversal of the Examiner's rejections is proper, and such favorable action is solicited.

Respectfully submitted,

By

A handwritten signature in black ink, appearing to read 'Thomas B. Luebbering', is written over a horizontal line.

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IX. Appendix

Claims 12-14 have been withdrawn from consideration.

Claims 1-11 and 15-18, the rejections of which are on appeal, read as follows.

1. A timing device for timing discrete periods of time, the device comprising:
at least one timer operable to measure the passing of a particular period of time
without reference to the actual time of the day or to any specific hour or
minute of the day, the length of the particular period of time being adjustable
and the adjustability being limited to multiples of a discrete number of
minutes or hours;
at least one input device operable to allow for adjusting the length of the particular
period of time;
a controller operable to provide feedback signals relating to the operation and
operative mode of the timing device, and further operable to produce an
alarm signal;
at least one speaker; and
a voice chip operable to combine with the speaker and the controller to convert the
feedback signals to audible human speech.
2. The device of claim 1, further comprising an ear-phone jack operable to
provide a connection point for ear-phones the connection of which causes the speaker to
cease operating while the ear-phones are connected.
3. The device of claim 1, the input device being a button.

4. The device of claim 1, the discrete number of minutes being fifteen minutes.
5. The device of claim 1, the discrete number of hours being one hour.
6. A timing device for timing discrete periods of time, the device comprising:
 - at least one timer operable to measure the passing of a particular period of time without reference to the actual time of the day or to any specific hour or minute of the day, the length of the particular period of time being adjustable and the adjustability being limited to multiples of a discrete number of minutes or hours;
 - at least one input device operable to allow for adjusting the length of the particular period of time;
 - a controller circuit operable to provide feedback signals relating to the operation and operative mode of the timing device, and further operable to produce an alarm signal;
 - at least one speaker;
 - at least one memory device operable to record and store a message for future playback; and
 - a voice chip operable to combine with the speaker, the memory device, and the controller to convert the feedback signals and the message into audible human speech.

7. The device of claim 6, further comprising an ear-phone jack operable to provide a connection point for ear-phones the connection of which causes the speaker to cease operating while the ear-phones are connected.

8. The device of claim 6, the input device being at least one button.

9. The device of claim 6, the discrete number of minutes being fifteen minutes.

10. The device of claim 6, the discrete number of hours being one hour.

11. The device of claim 6, the device further comprising a microphone.

15. A timing device for timing discrete periods of time, the device comprising:
at least one timer operable to measure the passing of a particular period of time
without reference to an actual time of a day, with the length of the particular
period of time being setable and the setability being limited to multiples of
one or more discrete time units;
at least one input device operable to allow for setting the length of the particular
period of time, wherein measurement of the particular period of time is
initiated automatically following setting of the particular period of time;
a controller operable to provide feedback signals relating to the operation of and
operative mode of the timing device, and further operable to produce an
alarm signal; and
at least one speaker operable to communicate the feedback signals and the alarm
signal.

16. The timing device as set forth in claim 15, wherein the one or more discrete
time units includes a discrete time unit corresponding to fifteen minutes.

17. The timing device as set forth in claim 15, wherein the one or more discrete
time units includes a discrete time unit corresponding to one hour.

18. A timing device for timing discrete periods of time, the device comprising:

- at least one timer operable to measure the passing of a particular period of time without reference to an actual time of a day, with the length of the particular period of time being setable and the setability being limited to multiples of two or more discrete time units, wherein the two or more discrete time units include a first discrete time unit corresponding to fifteen minutes and a second discrete time unit corresponding to one hour;
- at least one input device operable to allow for setting the length of the particular period of time, wherein measurement of the particular period of time is initiated automatically following setting of the particular period of time;
- a controller operable to provide feedback signals relating to the operation of and operative mode of the timing device, and further operable to produce an alarm signal;
- at least one memory device operable to record and store a message for future playback;
- at least one speaker operable to communicate the feedback signals, the alarm signal, and the message; and
- an ear-phone jack operable to connect one or more earphones to the timing device and operable to communicate the feedback signals, the alarm signal, and the message, wherein the speaker is disabled while the ear-phone jack is in use.



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of

KLOSTERMAN, WADE C.

Serial No. 09/613,514

Filed: 07/10/2000

Title: VOICE FEEDBACK TIMER SYSTEM

Group Art Unit 2859

Examiner: Vit W. Miska

TRANSMITTAL

Transmitted herewith are: Transmittal of Appeal Brief; Appeal Brief (31 pgs) in Triplicate; Filing Fee of \$160.00; Express Mail Transmittal; and Return Postcard. These document(s) are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: The Assistant Commissioner for Patents, Washington, D.C. 20231 on January 21, 2003.

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("Express Mail" Mailing Label Number)

Respectfully submitted,

HOVEY WILLIAMS LLP

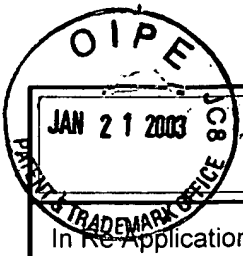
By

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ATTORNEYS FOR APPLICANT

(Docket No. 27553)

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JAN 21 2003

TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.
27553

In Re Application Of:

KLOSTERMAN, Wade C.

Serial No.
09/613,514Filing Date
07/10/2000Examiner
Miska, Vit W.Group Art Unit
2841

Invention: VOICE FEEDBACK TIMER SYSTEM

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:
December 11, 2002

Applicant is a small entity under 37 CFR 1.9 and 1.27.

A verified statement of small entity status under 37 CFR 1.27:

- ☐ is enclosed.
- ☒ has already been filed in this application.

The fee for filing this Appeal Brief is: \$160.00

- ☒ A check in the amount of the fee is enclosed.
- ☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. A duplicate copy of this sheet is enclosed.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 19-0522
A duplicate copy of this sheet is enclosed.

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Dated: January 21, 2003

Thomas B. Luebbering, Reg. No. 37,874
HOVEY WILLIAMS LLP

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